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REMARKS

In a Final Office Action dated December 20, 2005, claims 1-37 and 39-41 were rejected under the first paragraph of 35 U.S.C. § 112 as allegedly failing to comply with the written description requirement; claims 1, 3, 4, 12 and 13 were rejected under 35 U.S.C. § 102 in view of House; claims 2, 5-11 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Joseph; claims 15-33 were rejected under 35 U.S.C. § 103(a) in view of Official Notice; claims 34-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Hartman and Official Notice; claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Official Notice; and claims 39-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Hartman. The §§ 112, 102 and 103 rejections are addressed below.

§ 112 Rejections:

Independent claim 1 was rejected under 35 U.S.C. § 112, first paragraph, due to the language "to select an unavailable product or attribute that is not offered for sale"

However, the specification describes that in response to a selection of an unavailable attribute, the seller may reject the request. *See, for example,* step 66 in Fig. 3 and the associated text in the specification on page 9. Thus, the specification describes the use of a product/attribute selector to select an unavailable product or attribute that is not offered for sale, i.e., the seller has rejected the selection. Therefore, for at least this reason, the specification provides a written description of the invention that is set forth in independent claim 1.

Therefore, for at least these reasons, withdrawal of the § 112, first paragraph rejections of claims 1-14 is requested.

Similarly, independent claim 15 recites an unavailable product/attribute selector, "to select one of a product and attribute that cannot be ordered from the provider." As set forth above in the discussion of independent claim 1, the specification clearly describes an embodiment in which the seller rejects a request from a customer for a particular product or attribute. Specification, 9. Therefore, for at least this reason, withdrawal of the § 112, first paragraph rejections of claims 15-33 is requested.

Regarding the § 112, first paragraph rejections of claims 34-36, claim 34 recites, "each of the unavailable products cannot be ordered from the seller." See discussion of independent claims 1 and 15 above. For at least the reason that the specification describes a scenario in

which the seller may reject an attempted order of a particular attribute or product, the specification provides a written description of the invention that is set forth in independent claim 34. As such, withdrawal of the § 112, first paragraph rejections of claims 34-36 is requested.

Regarding the § 112, first paragraph rejection of claim 37, this claim also recites an input that is received for a specification for an unavailable product that cannot be ordered from a seller. For reasons similar to those set forth above, the specification describes the rejection of a particular input by a user of a particular unavailable product and thus provides a written description of at least one embodiment for claim 37. As such, withdrawal of the § 112, first paragraph rejection this claim is requested.

Regarding the § 112, first paragraph rejections of claims 39-41, claim 39 recites an unavailable product/attribute selector that allows selection of products/attributes that cannot be ordered from a given provider. For similar reasons, withdrawal of the § 112 rejections of claims 39-41 is requested.

§ 103 Rejections:

In the Examiner's response of the traversal to the Official Notice taken in the First Office Action, the Examiner cites language from various references that will allegedly support the missing claim limitations. To clarify, Applicant was not challenging the specific limitations presented by the dependent claims but rather challenging that the alleged suggestion or motivation for the required modifications to House were not well known. In this regard, section 2143 of the M.P.E.P. requires that when a reference is modified, the prior art must contain the suggestion or motivation for the modification. The Examiner fails to show where the prior art contains a suggestion or motivation to modify House to derive the dependent claims. For example, claim 9 recites that a list of available products in an online catalog is provided in conjunction with an unavailable product/attribute selector. Thus, although the Examiner cites various references to show online catalogs that provide lists of available products, the Examiner still fails to show where the prior art contains the alleged suggestion or motivation to modify House so that House's Internet application contains lists of available and unavailable products. Without such a suggestion or motivation, a *prima facie* case of obviousness has not been established for dependent claim 9.

Similar objections still remain for the remaining claims rejected under § 103, such as claims 15, 37 and 39. In this regard, merely showing a piecewise combination of elements in the prior art is not sufficient by itself to establish a *prima facie* case of obviousness. Thus, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have modified the references to derive the claimed invention (*emphasis added*). M.P.E.P. § 2143.

§§ 102 and 103 Rejections of Claims 1-15:

House fails to teach or suggest an online catalog that has an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale. In the Examiner's response to Applicants previous arguments, the Examiner sets forth two interpretations of the language, "an unavailable product or attribute that is not offered for sale." Office Action, 24. The Examiner then contends that the first interpretation is not applied because the specification does not support this interpretation under § 112. However, as pointed out above in the discussion of the § 112, first paragraph rejections, the specification clearly supports the manufacturer or seller refusing to provide the product and using the selection as merely marketing research. Thus, for at least this reason, the Examiner is improperly excluding the first interpretation. Additionally, the second interpretation that is set forth by the Examiner describes a scenario in which there is clearly an offer for sale. In other words, the manufacturer has agreed to provide the product, the specifications are definite, and thus, an offer for sale exists. Thus, the second interpretation clearly is outside of the scope of claim 1.

As previously pointed, House fails to teach or even suggest providing an attribute or selector for a product or attribute that is not available for sale. The custom-built components of House are all available. Therefore, for at least this reason, House fails to anticipate independent claim 1.

Claims 2-15 are patentable for at least the reason that these claims depend from an allowable claim.

§ 103 Rejections of Claims 15-33:

As noted above, the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify House to derive the claimed invention; and for at least this reason, a *prima facie* case of obviousness has not been established for claim 15.

Thus, even in view of the Examiner's response to Applicant's traversal of the Official Notice, the Examiner still fails to show where the prior art allegedly teaches or suggests modifying House's system so that the system provides an unavailable product/attribute selector to select one a product and an attribute that cannot be ordered from a provider. All of House's products and attributes can be ordered from the provider. Thus, for at least this reason, a *prima facie* case of obviousness has not been set forth for independent claim 15.

Claims 16-33 are patentable for at least the reason that these claims depend from an allowable claim.

§ 103 Rejections of Claims 34-36:

The method of independent claim 34 recites providing a set of available product data records in a memory and also recites providing a set of unavailable product data records in a memory. Each unavailable product cannot be ordered from a seller.

House fails to teach or suggest providing a set of unavailable product data records, where each unavailable product cannot be ordered from a seller. Thus, if a customer orders a custom-built component, this component is available from the seller. The Examiner fails to show where House teaches or suggests such an unavailable product data record. Furthermore, the Examiner fails to show where the prior art contains a suggestion or motivation to modify House's system to include such product data records. Therefore, for at least this reason, a *prima facie* case of obviousness has not been set forth for independent claim 34.

Claims 35 and 36 are patentable for at least the reason that these claims depend from an allowable claim.

§ 103 Rejection of Claim 37:

House fails to teach or suggest providing a specification for an unavailable product that cannot be ordered from a seller and for at least this reason, fails to teach or suggest the

limitations of independent claim 37. Thus, withdrawal of the § 103 rejection of claim 37 is requested.

§ 103(a) Rejection of Claim 38:

Independent claim 38 recites providing a set of variance data records in a memory. Each variance data record contains an allowed variance to an associated available product. The method includes displaying the set of available product data records and the set of variance data records on a visual display.

Contrary to the limitations of independent claim 38, House fails to teach or suggest the variance records and display of the variance records that are set forth in independent claim 38.

The Examiner states that Official Notice is taken that is well known to have products already assembled and available. However, Applicant fails to see how this teaches or suggests the missing claim limitations, i.e., variance records that contain an allowed variance to an associated available product and displaying the set of variance records. Thus, House and the alleged Official Notice fails to teach or suggest all the limitations of independent claim 38. Furthermore, the Examiner fails to show where the prior art allegedly contains the suggestion or motivation to modify House to contain the variance records and display of such records. Thus, for at least any of these reasons, a *prima facie* case of obviousness has not been set forth for independent claim 38.

§ 103 Rejections of Claims 39-41:

The memory structure of independent claim 39 includes an available product list and an unavailable product/attribute selector that allows selections of products/attributes that cannot be ordered from a given provider.

House fails to teach or suggest providing a product /attribute selector that allows selection of products/attributes that cannot be ordered from a given provider; and for at least this reason, a *prima facie* case of obviousness has not been set forth for independent claim 39. Furthermore, the mere fact that it may be well known to maintain items in lists, does not supply the teaching limitations. Additionally, the Examiner has fails to show where the prior art contains the alleged suggestion or motivation to modify House to derive the missing claim

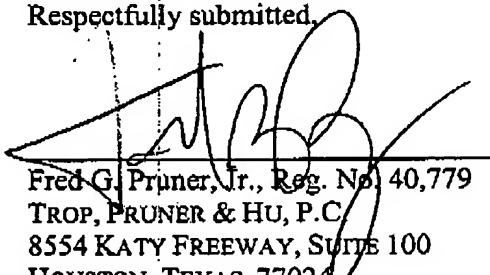
limitations. Therefore, for at least any of these reasons, a *prima facie* case of obviousness has not been set forth for independent claim 39.

Claims 40 and 41 are patentable for at least the reason that these claims depend from an allowable claim.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102, 103 and 112 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0293US).

Respectfully submitted,

  
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